

PTO Form 1857 (Rev 9/05)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78602188
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;">Acquired Distinctiveness Under Section 2(f)</p> <p>The mark "Healthcare Distribution Management Association" has been in substantially exclusive and continuous use as a trademark and service mark for the goods and services recited in the claimed U.S. Registration No. 2,888,102 from a date at least as early as January 1, 2001, to date. The term "Association" is disclaimed in this registration on the Principal Register under Section 2(f).</p> <p>Applicant was incorporated on a date at least as early as May 5, 1910, according to the enclosed print out from the online records of the government of the District of Colombia.</p> <p>The registered mark "Healthcare Distribution Management Association" begins with "Healthcare Distribution." This is almost identical to the "Healthcare Distributors" at beginning of the present mark. The goodwill associated with the registered mark would be associated with the present mark.</p> <p>There is no need for a disclaimer because the present mark is unitary, and has acquired distinctiveness because of the distinctiveness of the registered mark.</p> <p>At a minimum, it is submitted that Applicant has established distinctiveness in part of "Healthcare" in the present mark, in accord with TMEP §1212.09(b):</p> <p style="text-align: center;">1212.09(b) Claim of §2(f) "in Part" in §1(b) Application</p> <p>An intent-to-use applicant may also file a claim of acquired distinctiveness under §2(f) of the Trademark Act as to part of a mark before filing an acceptable amendment to allege use or statement of use. The claim must indicate that the applicant has already used the relevant part of the mark in commerce on or in connection with the specified goods or services or other goods or services as discussed above. See regarding claims of §2(f) distinctiveness "in part."</p> <p>Evidence in support of such a claim may consist of (1) ownership of a prior registration covering the relevant part of the mark and the same or related goods or services (<i>see et seq.</i>); (2) a <i>prima</i></p>	

facie showing of distinctiveness based on five years' use of the relevant part of the mark with the same or related goods or services (*see et seq.*); or (3) actual evidence of acquired distinctiveness of the relevant part of the mark with respect to the same or related goods or services (*see et seq.*). The examining attorney should consider the claim in the same manner as any other claim under §2(f).

If the examining attorney determines that the applicant has established acquired distinctiveness as to the relevant part of the mark, the examining attorney should withdraw any refusal related to the nondistinctive character of that part of the mark.

Request for Reconsideration

Please consider this a request for reconsideration. Applicant believes that this Response places the case in conditional for approval. In the alternative, Applicant submits that a new issue has been raised by the use of the registered mark, as compared to the mere claim of ownership of the registered mark, and that a new, non-final Office Action should be issued, in accord with TMEP §715.03(b) (April, 2005).

Conclusion

Applicant submits that the application should be approved for publication.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)

ORIGINAL
PDF FILE

http://teasgate/ROA/2006/12/22/20061222112557482883-78602188-001_001/evi_651641616-111406595_.2006-12-22_DC_government_online_printout.pdf

CONVERTED
PDF FILE(S)
(1 page)

\\TICRS\EXPORT\IMAGEOUT\7 86\021\78602188\xml1
ROA0 002.JPG

DESCRIPTION OF EVIDENCE FILE

image of page from the web site of the government of the District of Columbia

SIGNATURE SECTION

RESPONSE SIGNATURE

/ThomasJMoore/

SIGNATORY'S NAME

Thomas J. Moore

SIGNATORY'S POSITION

Owner's Attorney

DATE SIGNED

12/22/2006

FILING INFORMATION SECTION

SUBMIT DATE

Fri Dec 22 11:25:57 EST 2006

TEAS STAMP

USPTO/ROA-65.164.161.6-20
061222112557482883-786021
88-3606a212739e883ee3516c
45aacef75c58-N/A-N/A-2006
1222111406595901

PTO Form 1957 (Rev 9/05)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **78602188** has been amended as follows:

Argument(s)

In response to the substantive refusal(s), please note the following:

Acquired Distinctiveness Under Section 2(f)

The mark "Healthcare Distribution Management Association" has been in substantially exclusive and continuous use as a trademark and service mark for the goods and services recited in the claimed U.S. Registration No. 2,888,102 from a date at least as early as January 1, 2001, to date. The term "Association" is disclaimed in this registration on the Principal Register under Section 2(f).

Applicant was incorporated on a date at least as early as May 5, 1910, according to the enclosed print out from the online records of the government of the District of Colombia.

The registered mark "Healthcare Distribution Management Association" begins with "Healthcare Distribution." This is almost identical to the "Healthcare Distributors" at beginning of the present mark. The goodwill associated with the registered mark would be associated with the present mark.

There is no need for a disclaimer because the present mark is unitary, and has acquired distinctiveness because of the distinctiveness of the registered mark.

At a minimum, it is submitted that Applicant has established distinctiveness in part of "Healthcare" in the present mark, in accord with TMEP §1212.09(b):

1212.09(b) Claim of §2(f) "in Part" in §1(b) Application

An intent-to-use applicant may also file a claim of acquired distinctiveness under §2(f) of the Trademark Act as to part of a mark before filing an acceptable amendment to allege use or statement of use. The claim must indicate that the applicant has already used the relevant part of the mark in commerce on or in connection with the specified goods or services or other goods or services as discussed above. See regarding claims of §2(f) distinctiveness "in part."

Evidence in support of such a claim may consist of (1) ownership of a prior registration covering the relevant part of the mark and the same or related goods or services (*see et seq.*); (2) a *prima facie* showing of distinctiveness based on five years' use of the relevant part of the mark with the same or related goods or services (*see et seq.*); or (3) actual evidence of acquired distinctiveness of the relevant part of the mark with respect to the same or related goods or services (*see et seq.*). The

examining attorney should consider the claim in the same manner as any other claim under §2(f).

If the examining attorney determines that the applicant has established acquired distinctiveness as to the relevant part of the mark, the examining attorney should withdraw any refusal related to the nondistinctive character of that part of the mark.

Request for Reconsideration

Please consider this a request for reconsideration. Applicant believes that this Response places the case in conditional for approval. In the alternative, Applicant submits that a new issue has been raised by the use of the registered mark, as compared to the mere claim of ownership of the registered mark, and that a new, non-final Office Action should be issued, in accord with TMEP §715.03(b) (April, 2005).

Conclusion

Applicant submits that the application should be approved for publication.

Evidence

Evidence in the nature of image of page from the web site of the government of the District of Columbia has been attached.

Original PDF file:

http://teasgate/ROA/2006/12/22/20061222112557482883-78602188-001_001/evi_651641616-111406595_2006-12-22_DC_government_online_printout.pdf

Converted PDF file(s) (1 page)

Evidence-1

Response Signature

Signature: /ThomasJMoore/ Date: 12/22/2006

Signatory's Name: Thomas J. Moore

Signatory's Position: Owner's Attorney

Serial Number: 78602188

Internet Transmission Date: Fri Dec 22 11:25:57 EST 2006

TEAS Stamp: USPTO/ROA-65.164.161.6-20061222112557482

883-78602188-3606a212739e883ee3516c45aac

ef75c58-N/A-N/A-20061222111406595901



Organization Information

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Business Resource Center
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Compliance/Enforcement
Organization Registration
Inspections
Land Plats
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Status
Permits

INFORMATION

ONLINE SERVICE REQUESTS

Online Organization Registration

Search Registered Organizations

Organization Details - Step 1 2 3

To view another organization from the search, select the **Return to Search Results** button below. You may also print the organization details, or start a new search. Use the **Back to Main Page** button to continue the registration process.

Organization	Registered Agent
Organization Name: HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION State: DC Status: ACTIVE Initial Date of Registration: 5/5/1910 File No.: 670194 Organization Type: DOMESTIC NON PROFIT CORPORATION	C T Corporation System 1015 15th Street, N.W. Ste 1000 Washington, DC 20005

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